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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/821,480

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David W. Cannell

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,480

Applicant(s)

CANNELL ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-155 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-155 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1615 is running a fax response pilot for Restriction Pilot for Written Restriction Requirements. A dedicated fax machine is in place to receive your responses. The Fax number is (703)- 746-5215. A Fax cover sheet is attached to this office action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact, Thurman Page, Supervisory Patent Examiner, at (703)-308-2927. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to written restrictions.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-40, drawn to a composition, classified in class 424, subclass 70.2.
 - II. Claims 41-85, 152 and 153 drawn to a method for non-permanent shaping and shape retention, classified in class 424, subclass 70.1.
 - III. Claims 86-119, 154 and 155, drawn to a method of non-permanent shaping of hair, classified in class 424, subclass 70.1.
 - IV. Claims 120-151, drawn to a composition, classified in class 424, subclass 70.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

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product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the method of non-permanent shaping of hair (group II) can be performed with a composition comprising a compound chosen from C3 to C5 monosaccharides alone (as applicants themselves claimed in claims 86-119 belonging to the above group IV) and does not ^{require} the combination of C3 to C5 monosaccharides and film forming polymer (group I). Hence the group II and I are distinct.

3. For the same reasons provided in the above paragraph, group II is distinct from the method of group III because the hair shaping method of group II requires a combination of monosaccharides and a film former, which is not required for the method of group III.

4. The method of shaping the hair of group III is distinct from the composition of group IV because the method can be carried out by a composition of group I (containing both C3 to C5 monosaccharides and a film former) as well as a composition containing only C3 to C5 monosaccharides (group IV).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups I, III or IV, restriction for examination purposes as indicated is proper.

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7. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III or group IV, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Groups I, II or IV, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Groups I, II or III, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention: If applicants elect group I or group II, they required to elect one of the following species from each of the sub-groups:

A. Film forming agent:

1. Cationic polymers (claims 3, 4, 46 and 47)
2. Nonionic polymers (claims 5, 6, 48 and 49)
3. Anionic polymers (claims 7, 8, 9 and 50-52)

B. Compound chosen from C3 to C5 monosaccharides

1. Pentoses and their derivatives (claims 12-15, 25-28, 55-58, 68-72, 90-93, 103-107, 122-125 and 135-139)

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2. Tetroses and their derivatives (claims 16-19, 25-58, 59-62, 68-72, 94-97, 103-107, 126-129 and 135-139)
3. Trioses and their derivatives (claims 20-23, 25-28, 63-66, 68-72, 98-101, 113-107, 130-133 and 135-139)
4. Furanoses (claims 24, 67, 102 and 134)

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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14. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. A telephone call was made to Mark Sweet on 4-4-02 to request an oral election to the above restriction requirement, but did not result in an election being made.

16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S. Channavajjala
Examiner
Art Unit 1615
April 18, 2002